

REMARKS

By this Amendment, Applicants amend the abstract and claims 1-4, 6-12, 14, 16, 18-20, 22-32, and 34-40. Claims 1-14, 16, and 18-40 are pending in this application.

In the Office Action,¹ the Examiner objected to the abstract; provisionally rejected claims 1-14, 16, and 18-40 on the ground of non-statutory obviousness-type double patenting; rejected claims 1-11, 13, 14, 16, 18-27, and 29-39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,548,750 to Larsson et al. ("*Larsson*") in view of U.S. Publication No. 2003/0004975 to Nakano ("*Nakano*"); and objected to claims 12, 28, and 40 as being dependent upon a rejected base claim, but indicated that the claims would be allowable if rewritten in independent form.

Objection to the Abstract

The Examiner objected to the abstract "because it is not in accordance with the Office requirements." Office Action at 2. In response, Applicants amend the abstract. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the objection to the abstract.

Provisional Non-Statutory Obviousness-Type Double Patenting Rejection

Applicants respectfully traverse the provisional rejection of claims 1-14, 16, and 18-40 on the ground of non-statutory obviousness-type double patenting rejection over

¹ The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

claims 1-12 and 15-31 of U.S. Application No. 10/526,747 ("the '747 application"), and request that the provisional rejection be held in abeyance.

The '747 application is currently pending and, thus, no double patenting circumstances can arise until a patent is granted. Since no patent has apparently issued from the '747 application, Applicants respectfully request that the provisional rejections be held in abeyance and any resolution in the form of a terminal disclaimer or otherwise be deferred.

Applicants further note that M.P.E.P. § 804 addresses the situation of two co-pending applications. The section indicates that "[t]he 'provisional' double patenting rejection should continue to be made by the examiner in each application . . . unless that 'provisional' double patenting rejection is the only rejection remaining in one of the applications. If the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent." See M.P.E.P. § 804. Therefore, Applicants request the provisional double-patenting rejection be withdrawn should it be the only remaining rejections in this application or the '747 application and neither application has resulted in a granted patent.

Rejection of Claims 1-11, 13, 14, 16, 18-27, and 29-39 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-11, 13, 14, 16, 18-27, and 29-39 under 35 U.S.C. § 103(a) as being unpatentable over *Larsson* in view of *Nakano*. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” M.P.E.P. § 2142(III), 8th Ed., Rev. 6 (Sept. 2007). “[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . are as follows:

(A) [Determining the scope and content of the prior art;]

(B) Ascertaining the differences between the claimed invention and the prior art;
and

(C) Resolving the level of ordinary skill in the pertinent art.”

M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the scope and content of the prior art have not been properly determined and the differences between the claimed invention and the prior art have not been properly ascertained. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1 recites a method comprising, for example, “storing the first type ID in a first lock object, indicating that the data object is being moved.”

Larsson discloses a “BackupSynch variable in LID table” (Fig. 12) and “[i]f [BackupSynch] is equal to ‘include[,]’ the object will be copied to the backup area, [and] if [BackupSynch] is equal to ‘exclude[,]’ the object will not be copied” (col. 8, lines 5-10). However, the BackupSynch variable in the LID table of *Larsson* indicates which data object will be backed up, not which data object “is being moved,” as recited in claim 1 (emphasis added).

For example, *Larsson* teaches that when the BackupSynch variable “is equal to ‘exclude[,]’ the object will not be copied but the value of the [BackupSynch] variable is set to ‘Include’ as a preparation for the next backup.” *Larsson*, col. 8, lines 9-11. Because *Larsson* teaches setting the BackupSynch variable to “include” before the next backup is initiated, the BackupSynch variable of *Larsson* does not “indicat[e] that the data object is being [backed up],” as recited in claim 1 (emphasis added).

The Examiner states that “Nakano teaches deleting the ID from the permanent type lock object after the respective data object assigned to that ID has been deleted from the first storage location.” Office Action at 6. Applicants first note that neither Applicants’ claims nor *Nakano* mention “permanent type lock object.” Regardless, even assuming the Examiner’s characterization of *Nakano* in the Office Action is correct, which Applicants do not concede, *Nakano* fails to cure at least the above-discussed deficiencies of *Larsson*. That is, *Nakano* also fails to teach or suggest “storing the first

type ID in a first lock object, indicating that the data object is being moved," as recited in claim 1.

For at least the foregoing reasons, the scope and content of the prior art have not been properly determined, and the differences between the prior art and claim 1 have not been properly ascertained. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered claim 1 obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1.

Independent claims 14, 16, and 29, although different in scope from claim 1, are allowable for at least reasons similar to those given for claim 1. In addition, dependent claims 2-11, 13, 18-27, and 30-39, are allowable at least due to their dependence from allowable base claim 1, 16, or 29. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 1-11, 13, 14, 16, 18-27, and 29-39 under 35 U.S.C. § 103(a).

Objection to Claims 12, 28, and 40

Applicants appreciate the Examiner's indication of allowable subject matter. However, Applicants respectfully traverse the objection to claims 12, 28, and 40 as being dependent from a rejected base claim. As shown above, independent claims 1, 16, and 29, from which claims 12, 28, and 40 respectively depend, are allowable. Accordingly, Applicants respectfully request the Examiner to withdraw the objection to claims 12, 28, and 40.

CONCLUSION


In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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